

SOLICITOR

TO: Mail Stop 8 Director of the U.S. Patent & Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	DEC 19 2008 U.S. PATENT & TRADEMARK OFFICE	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
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In Compliance with 35 § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been
 filed in the U.S. District Court Northern District of California on the following ☒ Patents or ☐ Trademarks:

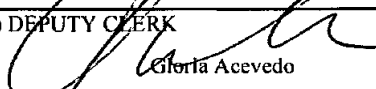
DOCKET NO. CV 08-05542 EMC	DATE FILED 12/10/08	U.S. DISTRICT COURT Northern District of California, San Francisco Division
PLAINTIFF SENDMAIL INC		DEFENDANT TUMBLEWEED COMMUNICATIONS
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 6,865,167		
2 6,986,037		
3 7,146,402		
4		
5		

In the above—entitled case, the following patent(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading		
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK	
1			
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK Richard W. Wieking	(BY) DEPUTY CLERK  Gloria Acevedo	DATE December 16, 2008
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Copy 1—Upon initiation of action, mail this copy to Commissioner Copy 3—Upon termination of action, mail this copy to Commissioner
 Copy 2—Upon filing document adding patent(s), mail this copy to Commissioner Copy 4—Case file copy

1 51. Plaintiff Sendmail has suffered and continues to suffer irreparable harm, for which
2 there is no adequate remedy at law, and will continue to do so unless Defendant Tumbleweed is
3 enjoined therefrom by this Court.

4 **COUNT NINE**

5 **CONTRIBUTORY PATENT INFRINGEMENT OF THE '402 PATENT**

6 52. On information and belief, Defendant Tumbleweed, in violation of 35 U.S.C.
7 § 271(c), has contributed and continues to contribute to the making, using, offering for sale or
8 selling within the United States, products or processes that practice inventions claimed in the
9 patent '402 patent.

10 53. On information and belief, Defendant Tumbleweed has had notice of its
11 contributory infringement of the '402 patent at least as early as the filing of this Complaint.

12 54. Plaintiff Sendmail has been damaged by the contributory infringement of the '402
13 patent by Defendant Tumbleweed and will continue to be damaged by such infringement.
14 Plaintiff Sendmail is entitled to recover from Defendant Tumbleweed the damages sustained by
15 Plaintiff Sendmail as a result of Defendant Tumbleweed's wrongful acts.

16 55. On information and belief, the continued contributory infringement by Defendant
17 Tumbleweed of the '402 patent is deliberate and willful, entitling Plaintiff Sendmail to increased
18 damages under 35 U.S.C. § 284 and to attorneys' fees and costs incurred in prosecuting this
19 action under 35 U.S.C. § 285.

20 56. Plaintiff Sendmail has suffered and continues to suffer irreparable harm, for which
21 there is no adequate remedy at law, and will continue to do so unless Defendant Tumbleweed is
22 enjoined therefrom by this Court.

23 **RELIEF REQUESTED**

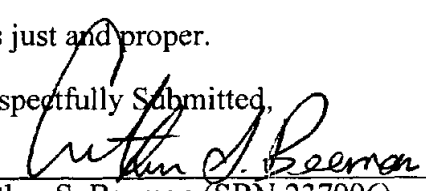
24 Wherefore, Plaintiff Sendmail respectfully requests that this Court enter judgment against
25 Defendant Tumbleweed as follows:

- 26 A. That each of the Patents-in-Suit is valid and enforceable;
27 B. That the '671 patent has been infringed by Defendant Tumbleweed;
28 C. That the '037 patent has been infringed by Defendant Tumbleweed;

- 1 D. That the '402 patent has been infringed by Defendant Tumbleweed;
2 E. That infringement of the Patents-in-Suit has been willful;
3 F. An injunction against further infringement of the Patents-in-Suit;
4 G. An award of damages adequate to compensate Plaintiff Sendmail for the patent
5 infringement that has occurred, together with pre-judgment interest and costs;
6 H. An award of all other damages permitted by 35 U.S.C. § 284, including increased
7 damages up to three times the amount of compensatory damages found;
8 I. That this is an exceptional case and an award to Plaintiff Sendmail of its costs and
9 reasonable attorneys' fees incurred in this action as provided by 35 U.S.C. § 285;
and
10 J. Such other relief as this Court deems just and proper.

11 Dated: December 10, 2008

Respectfully Submitted,


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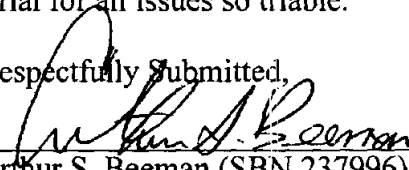
Attorneys for Plaintiff
SENDMAIL, INC.

DEMAND FOR JURY TRIAL

Plaintiff Sendmail hereby demands a jury trial for all issues so triable.

Dated: December 10, 2008

Respectfully Submitted,


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ORIGINAL
FILED

DEC 10 2008

RICHARD W. WIEKING
CLERK, U.S. DISTRICT COURT,
NORTHERN DISTRICT OF CALIFORNIA

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20 Attorneys for Plaintiff
21 SENDMAIL, INC

22 IN THE UNITED STATES DISTRICT COURT
23 FOR THE NORTHERN DISTRICT OF CALIFORNIA

24 SENDMAIL, INC., a Delaware
25 corporation,

26 Plaintiff

27 v.

28 TUMBLEWEED COMMUNICATIONS
CORP., a Delaware corporation,

Defendant.

CV 08

Civil Action No.

5542

COMPLAINT FOR PATENT
INFRINGEMENT

DEMAND FOR JURY TRIAL

EMC

1 Plaintiff Sendmail, Inc. ("Sendmail"), for its Original Complaint for Patent Infringement
2 ("Complaint") against Defendant Tumbleweed Communications, Corp. (hereafter,
3 "Tumbleweed"), alleges as follows:

4 **NATURE OF THE CASE**

5 1. This action arises under 35 U.S.C. § 271 for Tumbleweed's infringement of one or
6 more of Sendmail's United States Patent Nos. 6,865,671, 6,986,037, and 7,146,402 (collectively,
7 the "Patents-in-Suit").

8 **THE PARTIES**

9 2. Plaintiff Sendmail is a Delaware corporation, with its principal place of business at
10 6475 Christie Avenue, Suite 350, Emeryville, California.

11 3. On information and belief, Defendant Tumbleweed is a Delaware corporation with
12 its principal place of business at 71600 Seaport Boulevard, Redwood City, California.

13 4. On information and belief, Defendant Tumbleweed is a wholly-owned subsidiary
14 of Axway, Inc., and Axway, Inc. is a wholly-owned subsidiary of Sopra Group.

15 **JURISDICTION AND VENUE**

16 5. This is an action for patent infringement in violation of the Patent Act of the
17 United States, Title 35, United States Code. The Court has subject matter jurisdiction over this
18 action pursuant to 28 U.S.C. §§ 1331 and 1338(a).

19 6. Venue is proper in this District pursuant to 28 U.S.C. §§ 1391(b) and (c) and
20 1400(b) because a substantial part of the events or omissions giving rise to the claims occurred in
21 this District.

22 7. Personal jurisdiction exists over Defendant because Defendant has availed itself of
23 the privilege of doing business in California during the time relevant to this complaint.

24 **INTRADISTRICT ASSIGNMENT**

25 8. Pursuant to Local Rule 3-2(c), Intellectual Property Actions are assigned on a
26 district-wide basis.

PATENTS-IN-SUIT

9. Plaintiff Sendmail is the owner of all right, title, and interest in United States Patent No. 6,865,671 entitled "Electronic Mail System with Authentication Methodology for Supporting Relaying in a Message Transfer Agent" ("the '671 patent"). The '671 patent was duly and properly issued by the United States Patent and Trademark Office ("PTO") on March 8, 2005. A true and correct copy of the '671 patent is attached hereto as Exhibit A.

10. Plaintiff Sendmail is the owner of all right, title, and interest in United States Patent No. 6,986,037 entitled "Electronic Mail System with Authentication/Encryption Methodology for Allowing Connections to/from a Message Transfer Agent" ("the '037 patent"). The '037 patent was duly and properly issued by the PTO on January 10, 2006. A true and correct copy of the '037 patent is attached hereto as Exhibit B.

11. Plaintiff Sendmail is the owner of all right, title, and interest in United States Patent No. 7,146,402 entitled "E-mail System Providing Filtering Methodology on a Per-Domain Basis" ("the '402 patent"). The '402 patent was duly and properly issued by the PTO on December 5, 2006. A true and correct copy of the '402 patent is attached hereto as Exhibit C.

COUNT ONE

DIRECT PATENT INFRINGEMENT OF THE '671 PATENT

12. On information and belief, Defendant Tumbleweed, in violation of 35 U.S.C. § 271(a), has directly infringed and continues to directly infringe the '671 patent by making, using, offering for sale or selling within the United States, products or processes that practice inventions claimed in the '671 patent.

13. On information and belief, Defendant Tumbleweed has had notice of its direct infringement of the '671 patent at least as early as the filing of this Complaint.

14. Plaintiff Sendmail has been damaged by the direct infringement of the '671 patent by Defendant Tumbleweed and will continue to be damaged by such infringement. Plaintiff Sendmail is entitled to recover from Defendant Tumbleweed the damages sustained by Plaintiff Sendmail as a result of Defendant Tumbleweed's wrongful acts.

1 15. On information and belief, the continued direct infringement by Defendant
2 Tumbleweed of the '671 patent is deliberate and willful, entitling Plaintiff Sendmail to increased
3 damages under 35 U.S.C. § 284 and to attorneys' fees and costs incurred in prosecuting this
4 action under 35 U.S.C. § 285.

5 16. Plaintiff Sendmail has suffered and continues to suffer irreparable harm, for which
6 there is no adequate remedy at law, and will continue to do so unless Defendant Tumbleweed is
7 enjoined therefrom by this Court.

8 **COUNT TWO**

9 **INDUCING PATENT INFRINGEMENT OF THE '671 PATENT**

10 17. On information and belief, Defendant Tumbleweed, in violation of 35 U.S.C.
11 § 271(b), has induced and continues to induce others to make, use, offer for sale or sell within the
12 United States, products or processes that practice inventions claimed in the '671 patent.

13 18. On information and belief, Defendant Tumbleweed has had notice of its inducing
14 infringement of the '671 patent at least as early as the filing of this Complaint.

15 19. Plaintiff Sendmail has been damaged by the induced infringement of the '671
16 patent by Defendant Tumbleweed and will continue to be damaged by such infringement.
17 Plaintiff Sendmail is entitled to recover from Defendant Tumbleweed the damages sustained by
18 Plaintiff Sendmail as a result of Defendant Tumbleweed's wrongful acts.

19 20. On information and belief, the continued induced infringement by Defendant
20 Tumbleweed of the '671 patent is deliberate and willful, entitling Plaintiff Sendmail to increased
21 damages under 35 U.S.C. § 284 and to attorneys' fees and costs incurred in prosecuting this
22 action under 35 U.S.C. § 285.

23 21. Plaintiff Sendmail has suffered and continues to suffer irreparable harm, for which
24 there is no adequate remedy at law, and will continue to do so unless Defendant Tumbleweed is
25 enjoined therefrom by this Court.

1 **COUNT THREE**

2 **CONTRIBUTORY PATENT INFRINGEMENT OF THE '671 PATENT**

3 22. On information and belief, Defendant Tumbleweed, in violation of 35 U.S.C.
4 § 271(c), has contributed and continues to contribute to the making, using, offering for sale or
5 selling within the United States, products or processes that practice inventions claimed in the '671
6 patent.

7 23. On information and belief, Defendant Tumbleweed has had notice of its
8 contributory infringement of the '671 patent at least as early as the filing of this Complaint.

9 24. Plaintiff Sendmail has been damaged by the contributory infringement of the '671
10 patent by Defendant Tumbleweed and will continue to be damaged by such infringement.
11 Plaintiff Sendmail is entitled to recover from Defendant Tumbleweed the damages sustained by
12 Plaintiff Sendmail as a result of Defendant Tumbleweed's wrongful acts.

13 25. On information and belief, the continued contributory infringement by Defendant
14 Tumbleweed of the '671 patent is deliberate and willful, entitling Plaintiff Sendmail to increased
15 damages under 35 U.S.C. § 284 and to attorneys' fees and costs incurred in prosecuting this
16 action under 35 U.S.C. § 285.

17 26. Plaintiff Sendmail has suffered and continues to suffer irreparable harm, for which
18 there is no adequate remedy at law, and will continue to do so unless Defendant Tumbleweed is
19 enjoined therefrom by this Court.

20 **COUNT FOUR**

21 **DIRECT PATENT INFRINGEMENT OF THE '037 PATENT**

22 27. On information and belief, Defendant Tumbleweed, in violation of 35 U.S.C.
23 § 271(a), has directly infringed and continues to directly infringe the '037 patent by making,
24 using, offering for sale or selling within the United States, products or processes that practice
25 inventions claimed in the '037 patent.

26 28. On information and belief, Defendant Tumbleweed has had notice of its direct
27 infringement of the '037 patent at least as early as the filing of this Complaint.
28

1 29. Plaintiff Sendmail has been damaged by the direct infringement of the '037 patent
2 by Defendant Tumbleweed and will continue to be damaged by such infringement. Plaintiff
3 Sendmail is entitled to recover from Defendant Tumbleweed the damages sustained by Plaintiff
4 Sendmail as a result of Defendant Tumbleweed's wrongful acts.

5 30. On information and belief, the continued direct infringement by Defendant
6 Tumbleweed of the '037 patent is deliberate and willful, entitling Plaintiff Sendmail to increased
7 damages under 35 U.S.C. § 284 and to attorneys' fees and costs incurred in prosecuting this
8 action under 35 U.S.C. § 285.

9 31. Plaintiff Sendmail has suffered and continues to suffer irreparable harm, for which
10 there is no adequate remedy at law, and will continue to do so unless Defendant Tumbleweed is
11 enjoined therefrom by this Court.

12 **COUNT FIVE**

13 **INDUCING PATENT INFRINGEMENT OF THE '037 PATENT**

14 32. On information and belief, Defendant Tumbleweed, in violation of 35 U.S.C.
15 § 271(b), has induced and continues to induce others to make, use, offer for sale or sell within the
16 United States, products or processes that practice inventions claimed in the '037 patent.

17 33. On information and belief, Defendant Tumbleweed has had notice of its induced
18 infringement of the '037 patent at least as early as the filing of this Complaint.

19 34. Plaintiff Sendmail has been damaged by the inducing infringement of the '037
20 patent by Defendant Tumbleweed and will continue to be damaged by such infringement.
21 Plaintiff Sendmail is entitled to recover from Defendant Tumbleweed the damages sustained by
22 Plaintiff Sendmail as a result of Defendant Tumbleweed's wrongful acts.

23 35. On information and belief, the continued induced infringement by Defendant
24 Tumbleweed of the '037 patent is deliberate and willful, entitling Plaintiff Sendmail to increased
25 damages under 35 U.S.C. § 284 and to attorneys' fees and costs incurred in prosecuting this
26 action under 35 U.S.C. § 285.

1 36. Plaintiff Sendmail has suffered and continues to suffer irreparable harm, for which
2 there is no adequate remedy at law, and will continue to do so unless Defendant Tumbleweed is
3 enjoined therefrom by this Court.

4 **COUNT SIX**

5 **CONTRIBUTORY PATENT INFRINGEMENT OF THE '037 PATENT**

6 37. On information and belief, Defendant Tumbleweed, in violation of 35 U.S.C.
7 § 271(c), has contributed and continues to contribute to the making, using, offering for sale or
8 selling within the United States, products or processes that practice inventions claimed in the
9 patent '037 patent.

10 38. On information and belief, Defendant Tumbleweed has had notice of its
11 contributory infringement of the '037 patent at least as early as the filing of this Complaint.

12 39. Plaintiff Sendmail has been damaged by the contributory infringement of the '037
13 patent by Defendant Tumbleweed and will continue to be damaged by such infringement.
14 Plaintiff Sendmail is entitled to recover from Defendant Tumbleweed the damages sustained by
15 Plaintiff Sendmail as a result of Defendant Tumbleweed's wrongful acts.

16 40. On information and belief, the continued contributory infringement by Defendant
17 Tumbleweed of the '037 patent is deliberate and willful, entitling Plaintiff Sendmail to increased
18 damages under 35 U.S.C. § 284 and to attorneys' fees and costs incurred in prosecuting this
19 action under 35 U.S.C. § 285.

20 41. Plaintiff Sendmail has suffered and continues to suffer irreparable harm, for which
21 there is no adequate remedy at law, and will continue to do so unless Defendant Tumbleweed is
22 enjoined therefrom by this Court.

23 **COUNT SEVEN**

24 **DIRECT PATENT INFRINGEMENT OF THE '402 PATENT**

25 42. On information and belief, Defendant Tumbleweed, in violation of 35 U.S.C.
26 § 271(a), has directly infringed and continues to directly infringe the '402 patent by making,
27 using, offering for sale or selling within the United States, products or processes that practice
28 inventions claimed in the '402 patent.

1 43. On information and belief, Defendant Tumbleweed has had notice of its direct
2 infringement of the '402 patent at least as early as the filing of this Complaint.

3 44. Plaintiff Sendmail has been damaged by the direct infringement of the '402 patent
4 by Defendant Tumbleweed and will continue to be damaged by such infringement. Plaintiff
5 Sendmail is entitled to recover from Defendant Tumbleweed the damages sustained by Plaintiff
6 Sendmail as a result of Defendant Tumbleweed's wrongful acts.

7 45. On information and belief, the continued direct infringement by Defendant
8 Tumbleweed of the '402 patent is deliberate and willful, entitling Plaintiff Sendmail to increased
9 damages under 35 U.S.C. § 284 and to attorneys' fees and costs incurred in prosecuting this
10 action under 35 U.S.C. § 285.

11 46. Plaintiff Sendmail has suffered and continues to suffer irreparable harm, for which
12 there is no adequate remedy at law, and will continue to do so unless Defendant Tumbleweed is
13 enjoined therefrom by this Court.

14 COUNT EIGHT

15 INDUCING PATENT INFRINGEMENT OF THE '402 PATENT

16 47. On information and belief, Defendant Tumbleweed, in violation of 35 U.S.C.
17 § 271(b), has induced and continues to induce others to make, use, offer for sale or sell within the
18 United States, products or processes that practice inventions claimed in the '402 patent.

19 48. On information and belief, Defendant Tumbleweed has had notice of its inducing
20 infringement of the '402 patent at least as early as the filing of this Complaint.

21 49. Plaintiff Sendmail has been damaged by the induced infringement of the '402
22 patent by Defendant Tumbleweed and will continue to be damaged by such infringement.
23 Plaintiff Sendmail is entitled to recover from Defendant Tumbleweed the damages sustained by
24 Plaintiff Sendmail as a result of Defendant Tumbleweed's wrongful acts.

25 50. On information and belief, the continued induced infringement by Defendant
26 Tumbleweed of the '402 patent is deliberate and willful, entitling Plaintiff Sendmail to increased
27 damages under 35 U.S.C. § 284 and to attorneys' fees and costs incurred in prosecuting this
28 action under 35 U.S.C. § 285.